

REMARKS/ARGUMENTS

Favorable reconsideration of this application in view of the attached 37 CFR 1.131 declarations (one by Messrs. Eggleston and Hansen and one by Mr. Krebs) and the following remarks is respectfully requested.

Initially it should be noted that applicant is submitting herewith a 37 CFR 1.48(a) amendment requesting the deletion of Mr. Krebs as a joint inventor of the subject matter defined by the pending claims.

The Outstanding Rejections

Claims 33-68 are currently active in this case. In the outstanding office action, claims 56-63 and 65 were rejected under 35 USC 102(e) as being anticipated by US patent No. 5,742,668 to Pepe et al.; claims 33, 34, 40-47, 54, 55, and 64 were rejected under 35 USC 103(a) as being unpatentable over US patent No. 5,941,956 to Shirakihara et al. in view of US Patent No. 5,159,592 to Perkins; claims 35-38 were rejected under 35 USC 103(a) as being unpatentable over Shirakihara and Perkins further in view of Dunn; claim 39 was rejected under 35 USC 103(a) as being unpatentable over Shirakihara and Perkins further in view of Pepe; claims 48-53 were rejected under 35 USC 103(a) as being unpatentable over Shirakihara further in view of Pepe; and claims 66-68 were rejected under 35 USC 103(a) as being unpatentable over Pepe in view of Dunn.

Applicants acknowledge with appreciation the courtesy of an interview granted to co-inventor Eggleston and his representatives on May 17, 2007. As indicated in the interview summary, the outstanding prior art rejections were discussed. In particular, (a) the scope of Pepe was addressed and (b) the deficiencies of the November 09, 2006 37 CFR 1.131 Eggleston declaration, identified in the April 23, 2007 office action, were discussed. A declaration from inventors Eggleston and Hansen and a corroborating declaration for Mr.

Krebs are submitted herewith addressing the Examiner's concerns. A discussion of why Pepe does not anticipate claims 33-68 follows.

Briefly recapitulating, the present invention (claim 33) is directed to a method for forwarding messages between a host system and a mobile client. Reply messages generated by the mobile client and transmitted to the original message senders via the host system are configured "such that it will appear to the plurality of message senders that the reply messages originated at [a] first address associated with the host system." This feature is in the context of a method claim and is hereinafter referred to as the "transparency feature." By way of a non-limiting example of the transparency feature, the specification teaches on page 22 and illustrates in Figure 9 that a reply message is generated in step 902 at the mobile client. An optimized reply is forwarded to the communication server in step 906. In step 910, the Communication server (i.e. the host server) requests from the post office the preceding message (i.e., the message being replied to) using the message ID ("MSS.ID"). In step 914, the Communication server reconstructs the reply and forwards the same to the addressee (i.e., the original message sender) of the preceding message. Thus, in the context of this example, "configure" means to generate a reply message by reconstructing the proceeding message directed to the first address. Because the reply message is reconstructed from the preceding message directed to the first address, the original message sender is unaware that the reply was generated at the mobile client. Hence, the configuring the reply message step is referred to as the "transparency feature." See also page 9 of the Board's decision on appeal.

Similarly, claims 54, 55, 60, and 64 recite a transparency feature. Claim 54 recites the step of "receiving reply messages from the mobile client at the host system and configuring the reply messages such that it will appear to the plurality of message senders that the reply messages originated at the first address associated with the host system ...." Claim 55 recites

the step of receiving the reply messages at the host system and configuring the reply messages such that it will appear to the plurality of message senders that the reply messages originated at the first address associated with the host system ....” Claim 60 recites the step of “configuring the received message such that the received message appears to the message recipient as if the received message originated at the sender's first address, wherein messages generated at either the mobile client or host system appear to originate at the message sender's first address ....” Finally, claim 64 recites the steps of “configuring the outgoing messages so that the outgoing messages appear as if they were generated at either the mobile client or the host system; and transmitting the outgoing messages from the host system to message recipients.” Hence, each of the active independent method claims defines a transparency feature.

Independent claim 56 is directed to a computer system for forwarding messages from a mobile client. The computer system includes, by way of a non-limiting example, a host system 240 and a forwarding component 220 (i.e., the communication server). The forwarding component 220 is operable with the host system 240 such that, upon receiving a message generated at the mobile client 201, by a message sender destined for a message recipient, it configures the received message, prior to forwarding the message the message to the message recipient. The received message appears to the message recipient as if the received message originated at the sender's email address associated with the host system (see steps 910-914 of Figure 9), thereby allowing messages generated at either the mobile client 201 or host system 240 to appear to originate at the sender's email address associated with the host system. Claim 65 is directed to a computer readable medium with software instructions for enabling a method of forwarding messages including the steps of “configuring the received message such that the received message appears as if it were generated at either the mobile client or host system; and forwarding the configured received message to the message

recipient.” Thus, the software instructions embodied on a computer readable medium (claim 65) include the transparency feature.

### **Pepe**

Pepe is directed to a system for allowing a user to send or receive messages from a plurality of locations including the user’s PDA, home computer, and office PC. See Figure 19, column 3 lines 19-27, and column 22 lines 42-52 of Pepe.

The official action asserts that Pepe teaches with regard to claim 56 a computer system for forwarding messages from a mobile client. In particular, the paragraph bridging pages 2 and 3 of the official office action asserts that Pepe teaches in column 24, lines 27-31 that the PCI converts source addresses and that messages generated by the mobile client are routed at the PCI server and the PCI generates converted messages. Applicants respectfully traverse.

As discussed during the interview, Applicants respectfully submit that the Pepe PCI server functions as a protocol translator, but does not configure messages such that it will appear to the sender of the message being replied to that the reply message originated at a first address associated with the host system. That is, the PCI converts addresses found in the header of the message’s envelope for the purpose of routing messages within the system (e.g., converting from E.164 to X.400). The Pepe conversion step is necessary depending on where the message is being transmitted. For example, if the message is being transmitted to the user’s mobile PDA, then a first protocol would be used. However, if the message is being transmitted to the user’s home PC via a wireline data network, then a second and different protocol would be used. See Figure 19. However, Pepe does not teach or suggest that the PCI server configures the message such that it will appear to the sender of the message being replied to that the reply message originated at a first address associated with the host system irregardless of whether the reply message originated at a mobile device. That is, Pepe does

not configure the message such that the recipient will identify the sender based on the “from” field to be the first address as opposed to the address of the mobile client.

Applicants further point out that the protocol conversion utilized in Pepe is also disclosed by Applicants. See page 10 lines 9-17 of the Specification which state “[t]he protocol translators 222 serve to format or code the messages as appropriate for transport between the VSM 230 and client 201.” However, this protocol translator functionality is distinct from the functionality of the host/communication server illustrated, by way of non-limiting example, in Figure 9 and claimed in claim 56.

For the foregoing reasons, Pepe is not believed to anticipate or render obvious the subject matter defined by claim 56. In applying Pepe, the official action does not address the remaining independent claims separately. Applicants respectfully submit with regard to independent method claims 33, 54, 55, 60, and 64 that Pepe fails to teach or suggest the transparency feature identified with regard to those claims. With regard to independent claim 65, Applicants respectfully submit that Pepe fails to teach or suggest a computer readable medium embodying software instructions where the instructions enable a method of forwarding messages including the transparency feature identified above with regard to claim 65. Thus, Pepe is not believed to anticipate or render obvious the subject matter defined by claims 33, 54, 55, 60, 64, and 65.

#### **Shirakihara**

The official action asserts that Shirakihara renders obvious the subject matter defined by claims 33-53. The application that matured into the Shirakihara patent was filed on June 07, 1995. Applicants have submitted herewith a 37 CFR 1.131 declaration by inventors Eggleston and Hansen and a corroborating declaration by their colleague Mr. Krebs which establish that Applicants reduced to practice the subject matter of claims 33-53 prior to June

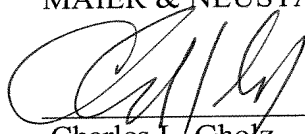
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07, 1995. Consequently, the Shirakihara patent is not available as 35 USC 102(e) art against Applicants' claims.

In view of the foregoing remarks and the attached declarations, no further issues are believed to be remaining. Applicants respectfully request that an interference be declared consistent with Applicants' Suggestion of an Interference.

Respectfully submitted,

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